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Justin Page

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CHRIS A. CASEIRO

VERRILL DANA, LLP

ONE PORTLAND SQUARE

PORTLAND, ME 04112-0586

EXAMINER

LE, MICHAEL

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/557,252	Applicant(s) PAGE, JUSTIN	
	Examiner MICHAEL LE	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Board Remand filed on March 25, 2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Summary and Status of Claims

2. This Office Action is in response to BPAI Remand issued March 25, 2008.
3. Claims 19-36 are pending.
4. Claims 26-36 are rejected under 35 U.S.C. 101.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

BPAI Remand Remarks

6. The BPAI remanded the case to the Examiner due to a question of support under 35 U.S.C. 112, first paragraph for the cited paragraphs in the primary reference, Tibor (U.S. Patent Pub 2004/0234117) since the Examiner relied upon the date of the parent, McNeal (US Patent 6,728,397). This office action is necessary to clarify the date of the prior art. In doing so, the Examiner has relied upon the parent patent, McNeal, in the prior art rejections below.

Claim Objections

7. Claims 1 and 26 are objected to because of the following informalities:

8. Claim 1 recites in the preamble that the claimed method is to “reclaim identity information obtained without authorization,” however, nowhere in claim 1 or the dependent claims is this limitation recited.

9. Claim 26 recites “notification means for notifying” in limitation (e). When invoking 112, sixth paragraph, the word "notification" is not needed and should be deleted.

10. Additionally, in claim 26, limitation (e), “one or more other database” has to be changed to –one or more databases--.

11. Appropriate correction is required.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. **Claims 26-36 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter.

14. The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

15. In the present case, **claims 26-36** recite a system, wherein the components of the system can be interpreted as software per se. In particular, this interpretation is re-enforced by claim 31, which claims the system of claim 26 as being embodied in one or more computer programs. For a system claim to be statutory, it must contain physical components in order to be categorized in a statutory category of machine or manufacture. In this case, the components are all software per se, which fails to meet the requirement. Thus, the system of claims 26-36 are directed toward nonstatutory subject matter.

16. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to overcome the rejection.

Claim Rejections - 35 USC § 103

17. **Claims 19-23 and 25-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNeal (US Patent 6,728,397), in view of Ranger (US Patent 5,999,940).**

18. In regards to **claim 19**, McNeal discloses a method to detect unauthorized attempts to detect identify information of an individual, to reclaim identity information obtained without authorization, to detect inaccuracies in identity information and to prevent unauthorized access to identity information, the method comprising the steps of:

- a. establishing a database of known private information of one or more individuals, wherein the known private information includes one or more of personal information, financial information, criminal information, and authorized users and storage of such information (McNeal at col. 4, lines 66-7; col. 5, lines 1-6);
- b. establishing indicia of unauthorized storage or use, or inaccuracies, of stored private information (McNeal at col. 7, lines 43-8);
- c. recording location information of the one or more other databases containing the stored private information (McNeal at col. 7, lines 7-10);
- d. comparing the known private information and the stored private information stored in the secure replication database (McNeal at col. 5, lines 38-42); and
- e. notifying the one or more individuals when the indicia of unauthorized storage or use, or inaccuracies, of stored private information are detected. McNeal at col. 6, lines 10-5.

19. McNeal does not expressly disclose persistently scanning the Internet for stored private information of the one or more individuals stored in one or more other databases, wherein the

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persistently scanning occurs without requiring initiation through an action of the one or more individuals and replicating the stored private information of the one or more other databases gathered from the step of persistently scanning to a secure replication database.

20. Ranger discloses agents that automatically collect information from other data sources, such as databases, from across a network, such as the Internet. Ranger at col. 19, lines 9-19.

21. McNeal and Ranger are analogous art because they are both directed toward the same field of endeavor of information retrieval and processing.

22. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the method of McNeal by adding the steps of persistently scanning the Internet for stored private information of the one or more individuals stored in one or more other databases, wherein the persistently scanning occurs without requiring initiation through an action of the one or more individuals and replicating the stored private information of the one or more other databases gathered from the step of persistently scanning to a secure replication database, as taught by Ranger.

23. The motivation for doing so would have been because it is inconvenient and manually intensive to constantly search the Internet for data. Thus, automated searching would be more convenient.

24. In regards to **claim 20**, McNeal in view of Ranger discloses the method as claimed in claim 19 further comprising the step of blocking access to the stored private information. McNeal at col. 6, lines 40-7.

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25. In regards to **claim 21**, McNeal in view of Ranger discloses the method as claimed in claim 19 further comprising the step of reporting unauthorized use or storage of stored private information, inaccurate stored private information, or a combination of the two. McNeal at col. 6, lines 11-5.

26. In regards to **claim 22**, McNeal in view of Ranger discloses the method as claimed in claim 19 wherein the database of known private information and the secure replication database form part of a common database. McNeal at Fig 2, element 30; col. 5, lines 32-7.

27. In regards to **claim 23**, McNeal in view of Ranger discloses the method as claimed in claim 19 wherein the step of notifying is performed by establishing a graphical user interface for the one or more individuals to observe one or more indicators of private information usage or stored based on the established indicia. McNeal at col. 6, lines 11-5.

28. In regards to **claim 25**, McNeal in view of Ranger discloses the method as claimed in claim 19 wherein the one or more other databases replicated include credit reporting service databases, court records databases, deed registry databases, and criminal record databases. McNeal at col. 4, lines 66-7; col. 5, lines 1-2; col. 7, lines 44-8.

29. **Claim 26** is essentially claim 19 in the form of a system and is rejected for the same reasons.

30. **Claim 27** is essentially claim 22 in the form of a system and is rejected for the same reasons.

31. In regards to **claim 28**, McNeal in view of Ranger discloses the system as claimed in claim 26 wherein the one or more databases are substantially continuously searched for stored private information. Ranger at col. 19, lines 9-19.

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32. In regards to **claim 29**, McNeal in view of Ranger discloses the system as claimed in claim 28 wherein the means for searching is a search agent program selected from the group consisting of web spiders, bots, and robots. Ranger at col. 1, lines 30-3.

33. In regards to **claim 30**, McNeal in view of Ranger discloses the system as claimed in claim 26 wherein the one or more databases include credit reporting service databases, court records database, deed registry databases, and criminal record databases. McNeal at col. 4, lines 66-7; col. 5, lines 1-2; col. 7, lines 44-8.

34. **Claim 31** is essentially claim 19 in the form of a computer readable medium and is therefore rejected for the same reasons.

35. In regards to **claim 32**, McNeal in view of Ranger discloses the system as claimed in claim 31, accessible through a computer interconnection system, wherein the one or more individuals providing the known private information may provide the known private information to the first database through the computer interconnection system, and may further access the notification means through the computer interconnection system. McNeal at col. 4, lines 66-7.

36. In regards to **claim 33**, McNeal in view Ranger discloses the system as claimed in claim 32 wherein the notification means includes an interactive graphical user interface. McNeal at col. 6, lines 11-5.

37. In regards to **claim 34**, McNeal in view of Ranger discloses the system as claimed in claim 26 further comprising an input device to enable the one or more individuals to report inaccurate private information, unauthorized usage of or access to the private information, or a combination of the two. McNeal at col. 6, lines 66-7; col. 7, lines 1-4.

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38. In regards to **claim 35**, McNeal in view of Ranger discloses the system as claimed in claim 26 further comprising a third database of one or more indicia of unauthorized storage or use of private information. McNeal at col. 7, lines 42-53.

39. In regards to **claim 36**, McNeal in view of Ranger discloses the system as claimed in claim 35 wherein the third database is updatable and is accessed by the means for comparing to detect difference between the known private information and the stored private information, to detect unauthorized use or storage of the stored private information, or a combination of the two. McNeal at col. 7, lines 42-53.

40. **Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over McNeal (US Patent 6,728,397), in view of Ranger (US Patent 5,999,940), further in view of Reyes (US Patent 5,818,030)**

41. In regards to **claim 24**, McNeal in view of Ranger do not expressly disclose wherein the one or more indicators include a green light representation to show acceptable usage or storage, a yellow light to show potentially unacceptable usage or storage, and a red light to show unacceptable usage or storage.

42. Reyes discloses a credit card system, which has features to prevent unauthorized usage. Reyes at col. 3, lines 40-6. The card system has three lights that are red, yellow, and green. Red indicates locked system and green indicates that the system is ok. Reyes at col. 8, lines 13-21.

43. McNeal, Ranger and Reyes are analogous art because they are all directed toward the same field of endeavor of information retrieval.

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44. At the time of the invention, it would have been obvious to one of ordinary skill in art to modify the combined method of McNeal and Ranger by making the one or more indicators be green, yellow and red, as taught by Reyes.

45. The motivation for doing so would have been because color coding allows for fast recognition of an event.

Response to Arguments

Rejection of claims 19-36 under 35 U.S.C. 103(a)

46. Applicant's arguments in regards to the rejections to claims 19-36 under 35 U.S.C. 103(a), have been fully considered but they are moot in view of the new grounds of rejection set forth above.

Conclusion

47. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Le whose telephone number is 571-272-7970. The examiner can normally be reached on Mon-Thurs : 9:30am-6pm, Fri: 8am-4:30pm.

48. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

49. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael Le/
Examiner, Art Unit 2163
/don wong/

Supervisory Patent Examiner, Art Unit 2163